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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,421	01/10/2002	David P. Billings	DOG 2410000	9060

7590

11/18/2004

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EXAMINER
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PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/043,421	<b>Applicant(s)</b> BILLINGS, DAVID P.	
	<b>Examiner</b> Sebastiano Passaniti	<b>Art Unit</b> 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 07/15/2004 – amendment.

Claims 1-28 remain pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 6, 7, 10, 12-16, 19, 21, 22, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutin et al in view of Zebelean ('549). The patent to Hutin shows every feature claimed with the exception of an opening. More specifically, Hutin fails to show an opening in either the sole, as required by claims 4 and 13, or the crown, as required by claims 5 and 14. Zebelean shows it to be old in the art to form a hollow metallic club head via a casting process and to include an opening in either the top or sole portion for access to the interior. Moreover, Zebelean notes that the number of shell parts may be selectively determined based upon cost consideration. The number of parts would clearly influence where the opening is located. See col. 5, lines 9-45 in Zebelean. In view of the patent to Zebelean, it would have been obvious to modify the device in the cited art reference to Hutin by introducing an opening in either the sole or crown, the motivation being to accommodate the manufacturing process and to provide access to the interior of the head. As for the

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remaining limitations in the claims and with respect to the Hutin reference, note that the dampers (10) housed on the interior walls of the club head clearly may serve as “weights”, as broadly as claimed. Specific to claims 12, 22 and 28, if either the crown or sole portions in Hutin are modified to form a cover portion, as outlined above and as modified by Zebelean, then each of these elements would include a damper portion (element 10 located outside of the shell). Hutin clearly shows a club head of the wood type, as required by claims 7 and 16.

Claims 1, 2, 4, 5, 7, 10, 13, 14, 16, 19, 21 and 25-28 are rejected under 35 USC 103(a) as being unpatentable over Wakita in view of Vincent and Desbiolles. Wakita shows every feature claimed with the exception of non co-linear weights. Vincent and Desbiolles show that it is old in the art of wood-type club heads to include multiple weights within the interior of the shell, arranged in such a manner that the center of gravity either may be shifted not only from the front-to-back of the head, but also in the top-to-sole direction of the head. See Figures 14-16 and col. 7, lines 17-43 in Vincent. See Figures 7A and 7B and col. 4, line 4 through col. 5, line 14 in Desbiolles. In view of the patents to Vincent and Desbiolles, it would have been obvious to modify the device in the cited art reference to Wakita by including a plurality of weights in order to vary the location of the center of gravity. Note, there is nothing in Wakita that precludes the inclusion of added weights or location of the weight placement. Thus, insofar as the claimed requirements of new claims 25-28, one skilled in the art, using the guidance of Vincent and Desbiolles, would have found it obvious to place the strategically place the weights in order to achieve a desired weight distribution. With respect to the remaining

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limitations in the claims and regarding the Wakita patent, note that as to claims 1, 10 and 19, Figure 4 shows a club head (10) with a face (13), crown (14) side walls (not numbered) and sole portion (20). These parts form a hollow cavity within a substantially thin-walled structure. A port (opening) is provided through which a weighting material (24) may be placed within the hollow structure. As to claims 2, 10, and 19, note element (19) serving as a port closure. As to claims 4 and 13, the port is located on the sole side of the head. As to claims 5 and 14, Wakita contemplates placing the opening on a crown side, but does not recommend such placement of the port and closure for aesthetic reasons (col. 4, lines 8-22). As to claims 7 and 16, Wakita is clearly directed to a club of the wood-type. As to claim 21, Figure 4 clearly shows that the cover (19) fits in a flush manner with the remainder of the sole wall surface.

Claims 1, 2, 6, 8, 10, 15, 17 and 19 are rejected under 35 USC 103(a) as being unpatentable over Takeda in view of Sun ('041). Takeda shows every feature claimed with the exception of non co-linear weights. Sun shows it to be old in an iron-type club head to change the location of the center of gravity in a vertical as well as longitudinal direction. See Figures 1 and 2 as well as col. 1, line 65 through col. 2, line 5 in Sun. In view of the patent to Sun, it would have been obvious to modify the device in the cited art reference to Takeda by including a plurality of weights in order to desirably vary the location of the center of gravity. With respect to the remaining limitations in the claims, note Figure 4 and the description in column 4, line 66 through column 5, line 50, wherein Takeda details an iron-type club head with a main body (1), a hollow interior

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(8), a port or opening closed by cover (17) and a weight material (26) placed within the hollow interior.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda in view of Sun ('041) and Mills. To have modified the device in the Takeda reference to include weights in the form of lead tape in order to take advantage of another convenient manner of applying and securing a weight to the cavity structure would have been obvious in view of the patent to Mills, which shows it to be old in the art to make use of lead tape for selectively providing weight to a hollow (cavity) within a club head structure.

Claims 1, 2, 3, 4, 9, 11, 12, 13, 18, 22, 23 and 24 are rejected under 35 USC 103(a) as being unpatentable over MacIntyre in view of Antonious ('459). MacIntyre shows every feature claimed with the exception of specifically noting that the weights are non co-linear to enable adjustment of the center of gravity. Antonious shows it to be old in the art to arrange weights in a vertical direction within the body of a putter-style club head in order to help provide a desirable weight distribution. See col. 1, line 5-45, col. 2, line 54 through col. 3, line 8 and Figures 9-14. In view of the patent to Antonious, it would have been obvious to modify the device in the cited art reference to MacIntyre by varying the position of the weights (40) so that a non co-linear relationship exists, the motivation being to vary the location of the center of gravity. Insofar as the remaining limitations in the claims and as to claims 1, 10 and 19, note that the MacIntyre device includes a top surface (11), sole (10), striking face (12) and peripheral heel and toe ends (17, 18). The assembly creates a substantially hollow interior that is sealed off by

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a cover plate (36) and retains weight members therein. As to claims 2, 10 and 19, here again, note cover (36). As to claims 3, 12, 22, 23 and 24, note the language in column 3, lines 16-45, wherein MacIntyre details that hard rubber washers (45) that are slightly compressed are used just below the cover plate (36) to help prevent rattling of the weight members. As to claims 4 and 13, the port is located in the sole portion of the head. As to claims 9 and 18, MacIntyre clearly shows a putter-style club head.

#### RESPONSE TO ARGUMENTS

Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
November 15, 2004